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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,739	11/12/2003	Tyson Winarski	108/118	7546

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EXAMINER

KATCHEVES, BASIL S

ART UNIT	PAPER NUMBER
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3635

DATE MAILED: 06/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/706,739

Applicant(s)

WINARSKI, TYSON

Examiner

Basil Katcheves

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the pane comprised of solar cells and beam splitters, as claimed in claims 8 and 9 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 8 and 9 are not supported in the specification.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-6 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 16 of U.S. Patent No. 6,688,053. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Regarding claim 1, '053 claims a double pane window having a plurality of solar cells and diachronic mirrors between panes (claim 1), not a single solar cell and diachronic mirror. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify '053 by using only a single solar cell and dichronic mirror in order to increase viewable window space.

Regarding claim 2, '053 claims a window that generates electricity comprising a plurality of beam splitters and solar cells between panes (claim 16) but not the solar cell adjacent to the beam splitter. It would have been obvious to one having ordinary skill in

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the art at the time the invention was made to modify '053 by placing the solar cells adjacent the beam splitters to reduce any air gap and avoid condensation.

Regarding claim 3, '053 claims receiving light through a pane and directing a portion of the light onto a solar cell but not directing another portion of light through a pane (claim 1). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify '053 by passing the other portion of light through the pane in order to provide light inside a structure.

Regarding claim 4, '053 claims a beam splitter (claim 16).

Regarding claim 5, '053 claims a dichronic mirror (claim 1).

Regarding claim 6, '053 claims a second pane and the solar cell is positioned between the two panes (claim 1).

Claim 7 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,688,053 in view of applicants disclosure of Nikon diachronic coatings on page 13 of applicant's specification.

Regarding claim 7, '053 claims a window which generates light by using a solar cell and dichronic mirrors (claim 1). However, '053 does not claim a diachronic coating on a window pane. Nikon discloses a diachronic coating on a window pane (applicant's specification, page 13). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify '053 by adding the dichronic coating to the pane, as disclosed by the applicant, in order to reduce the size of the window assembly.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 3 and 6 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,228,925 to Nath et al.

Regarding claim 3, Nath discloses a window pane (fig. 3: 12) which generates electricity by receiving light adjacent a first pane (fig. 3: 12), a first portion of the light is directed onto a solar cell (fig. 3: 14) and a second portion of light is transmitted through the window (fig. 3: 12).

Regarding claim 6, Nath discloses a second pane (fig. 3: 18).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4, 5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,228,925 to Nath et al. in view of U.S. Patent No. 6,337,038 to Lee et al.

Regarding claim 1, Nath discloses a double pane window assembly (fig. 2) which generates electricity comprising a first (fig. 2: 18) and second (fig. 2: 12) pane, and a solar cell (fig. 2: 14) between panes. However, Nath does not disclose the use of a diachronic mirror. Lee discloses the use of a diachronic window (abstract) for varying the degree of light transmissions. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Nath by using a dichronic pane, as disclosed by Lee, in order to shade the occupants of the vehicle under extreme sun light.

Regarding claim 2, Nath discloses a double pane window assembly (fig. 2) which generates electricity comprising a first (fig. 2: 18) and second (fig. 2: 12) pane, and a solar cell (fig. 2: 14) between panes. However, Nath does not disclose the use of a light beam splitter which allows light to pass onto the solar cells and through the window. Lee discloses the use of a diachronic window (abstract) which splits light (column 1, lines 53-58) for varying the degree of light transmissions. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Nath by using a dichronic pane, as disclosed by Lee, in order to shade the occupants of the vehicle under extreme sun light. Also, when allowing light to pass, the dichronic pane would thereby pass light onto the solar cell (fig. 3: where 14 points) and also allow light to pass through the window (fig. 3: where 18 points) onto the occupant.

Regarding claim 4, Nath does not disclose a beam splitter. Lee et al. Discloses a beam splitting variable light transmission window (abstract, column 1: lines 53-58). It would have been obvious to one having ordinary skill in the art at the time the invention

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was made to modify Nath by using the beam splitting variable light transmitting window, as disclosed by Lee, as a replacement for fig. 3: 18 in order to shade the occupants of the vehicle from extreme sun light.

Regarding claim 5, Nath does not disclose a dichronic mirror. Lee et al. Discloses a dichronic, variable light transmission window (abstract, column 1: lines 53-58). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Nath by using the dichronic pane, as disclosed by Lee, as a replacement for fig. 3: 18 in order to shade the occupants of the vehicle from extreme sun light.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,228,925 to Nath et al. in view of applicants disclosure of Nikon diachronic coatings on page 13 of the specification.

Regarding claim 7, Nath discloses a window pane (fig. 2:18) which generates electricity comprising a solar cell (fig. 2: 14) between panes (fig. 2: 12 & 18). However, Nath does not disclose the use of a diachronic coated pane. Nikon discloses the use of a diachronic window coating (applicant's specification, page 13) for varying the degree of light transmissions. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Nath by using a dichronic coating, as disclosed by the applicant, in order to shade the occupants of the vehicle under extreme sun light.

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Allowable Subject Matter

Claims 8 and 9 appear to be drawn to allowable subject matter however, final determination of allowability for the claims will be made after all 35 U.S.C. 112 rejections have been corrected.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The cited patents listed on the included form PTO-892 further show the state of the art with respect to electricity generating windows in general.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Basil Katcheves whose telephone number is (703) 306-0232. The examiner can normally be reached on Monday-Friday from 7:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman, can be reached at (703) 308-0832.

BK


Basil Katcheves

6/2/04

Examiner AU 3635